UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,079	05/25/2000	Ananda Mohan	81045.943	6999

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EXAMINER
TRAN, TONGOC

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Application No.	Applicant(s)
09/579,079	MOHAN, ANANDA
Examiner	Art Unit	
Tongoc Tran	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>3/3/2004</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-37</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>28-37</u> is/are allowed.

6)☒ Claim(s) <u>1-13,16-23 and 25-27</u> is/are rejected.

7)☒ Claim(s) <u>14-15,24</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to applicant's amendment filed on 3/3/2004.

Claims 8, 10, 16, 21-22, 28 and 30. Claims 33-37 are added. Claims 1-37 are pending.

Response to Arguments

2.   Applicant's arguments filed 3/3/2004 have been fully considered but they are not

persuasive.

Response to Applicant's remark on 35 U.S.C. 102

A) Applicant contends that Linehan fails to anticipate generating a pair of distinct

encode and decode keys. In response to applicant's argument that the references fail

to show certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., <u>distinct</u> encoding and decoding keys) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

B) Applicant further contends that Linehan teaches away executing a secure

save command that comprises generating an encode key. Examiner disagrees.

Linehan discloses "each data file is encrypted by the Personal Key Client, on the user's

computer, using a randomly chosen key generating by the Personal Key Server"

(generating an encode key) "at the time the file is created" (file saved) (col. 7, lines 46-

53). Furthermore, the claim recites the step of executing a secure save file is on the first

computer and the step of generating the key is on the second computer. Therefore, it

suggests that once the file is created (or saved) in the first computer, a key is then generated in the second computer.

Applicant's arguments, see page 21-22, with respect to claims 14-15, 24 and 28 have been fully considered and are persuasive. Claims 14-15, 24 and 28 have been withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-9, 19-21, 23, 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Linehan et al. (U.S. Patent No. 5,495,533, hereinafter Linehan).

In respect to claims 1, 19 and 23, Linehan discloses a computer method and system for securing access to data, comprising:

"generating a first message at a first computer system, said first message comprising information corresponding to data, and transmitting said first message to a second computer system" (see col. 7, lines 46-53);

"receiving said first message at said second computer system, and generating a key paid comprising an encoding key and a decoding key for encoding and decoding of said data" (see col. 7, lines 46-64);

"generating a second message comprising said encode key, and transmitting

said second message to said first computer system" (see col. 7, lines 50-53); and

"receiving said second message at said first computer system, wherein said

encode key in said second message is used to encode said data" (see col. 7, lines 50-

53).

In respect to claim 2, Linehan disclose the method of claim 1 and further disclose

said method comprising:

"storing said key pair and said information in said first message in a database

record" (see col. 12, lines 62-67).

In respect to claims 3 and 20, Linehan discloses the method of claims 1 and 19

and further discloses said method comprising:

"encoding said data using said encode key, and storing said encoded data" (see

col. 12, lines 53-64).

In respect to claims 4, Linehan discloses the method of claim 1 wherein said "first

computer system comprises at least one client computer system and said second

computer system comprises at least one server computer system" (see col. 6, lines 29-

38).

In respect to claim 8, Linehan discloses a method of claim 3, further comprising:

"providing access to said encode data by performing steps comprising:

"generating a third message at a first computer system, said third message

comprising information corresponding to said encoded data, and transmitting said third

message to a second computer system" (see col. 7, lines 46-64);

"receiving said third message at said second computer and using said

information in said third message to retrieve a record corresponding to said encode

data, said record comprising said decode key for decoding said encode data" (see col.

7, lines 54-64);

"generating a fourth message comprising said decode key, and transmitting said

fourth message to said first computer system" (see col. 7, lines 60-64);

"receiving said fourth message at said first computer system, wherein said

decode key in said fourth message is utilized to decode said encode data" (see col. 7,

lines 63-64).

In respect to claims 9 and 21, Linehan discloses the method of claim 8 and 19

further comprising:

"accessing said encoded data and decoding said encoded data using said

decode key" (see col. 7, lines 63-64).

In respect to claims 25, Linehan discloses the method of 23 wherein "registration

functions are performed on said second computer system while said first computer

system and said second computer systems maintain a secure link to each other" (see

Fig. 7, item 73, col. 7, lines 5-14);

In respect to claim 26, Linehan discloses the method of claim 25

"wherein authentication functions are performed on said second computer

system while said first computer system and said second computer systems maintain a

secure link to each other" (see col. 7, lines 30-36, Personal Key Client-first computer,

Personal key Server-second computer);

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Linehan (U.S. Patent No. 5,495,533) in view of Holloway (U.S. Patent No. 6,424,718).

In respect to claim 16, Linehan discloses a method in a network computer

system providing access to encoded data, comprising:

"generating a first message at a first computer system, said first message

comprising information corresponding to said encoded data, and transmitting said first

message to a second computer system" (see col. 7, lines 46-64);

"receiving said first message at said second computer and using said information

in said first message to retrieve a record corresponding to said encode data, said record

comprising a decode key for decoding said encode data" (see col. 7, lines 54-64);

"generating a second message comprising said decode key, and transmitting

said second message to said first computer system" (see col. 7, lines 60-64);

"receiving said second message at said first computer system, wherein said

decode key in said second message are utilized to decode said encode data" (see col.

7, lines 63-64).

Linehan does not explicitly disclose said decode key differing from an encode key used to generate said encode data. However, Holloway teaches using public key system to generate public and private key. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Linehan's method with Holloway's public key method because public key is known to be more secure than the private key.

In respect to claim 17, Linehan discloses the method of claim 16 and further discloses said method comprising:

"accessing said encoded data and decoding said encoded data using said decode key" (see col. 12, lines 53-64).

In respect to claim 18, Linehan discloses the method of claim 16 wherein said "first computer system comprises at least one client computer system and said second computer system comprises at least one server computer system" (see col. 6, lines 29-38).

5.   Claim 5-7, 10-13, 27 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan (U.S. Patent No. 5,495,533) in view of Yatsukawa (U.S. Patent No. 6,148,404).

In respect to claims 5, Linehan discloses the method accessing secure data wherein said generating said first message further comprises:

"placing information identifying said data and user information associated with a user of said data at said first computer system in said first message" (see col. 7, lines

45-53). Linehan does not discloses generating a one way hash function associated with said data; and placing said one way hash function at said first computer in said first message. However, Yatsukawa discloses using hash processing to compress a message (see Fig. 4 and col. 14, lines 13-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teaching of Yatsukawa with Linehan to compress the data of said first message for the benefit of making the data smaller before it is being transmitted over the network.

In respect to claims 6, 10 and 30, Linehan and Yatsukawa disclose the method of accessing secure data and further disclose said method comprising:

"obtaining said first message at said second computer" (see col. 7, lines 46-48);

"storing said user information, said information identifying said data" (see col. 7, lines 54-60). Linehan do not disclose "generating a time stamp and a digital signature representing; and digital time stamp, and said one way hash function in said first message". However, Yatsukawa discloses a time stamp and digital signature before a message is sent (see Fig. 5, B1 and B4 and col. 14, lines 15-16), performing a hash processing on a message (see Fig. 4 and col. 14, lines 13-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Linehan's method of accessing secure data with the teaching of Yasukawa to provide time stamp with digital signature and compressing data with hash function into outgoing message for authentication and data verification purposes.

In respect to claims 7 and 31, Linehan and Yatsukawa disclose the method of claim 6 and 30. Yatsukawa further discloses wherein said second message further comprises:

"said time stamp, said information identifying said data and said digital signature in said second message (see Fig. 5, B2 and B4, col. 5, lines 35-39).

In respect to claim 11, Linehan discloses the method of claim 10 further comprising:

"receiving said third message at said second computer system; accessing said corresponding record" (see col. 7, lines 54-64).

Linehan do not disclose "verifying said digital signature therein with said received digital. However, Yatsukawa discloses received incoming message with digital signature and verifying said digital signature (see Fig. 5, Server B, B4: inspect Sa). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Yasukawa to provide receiving and verifying of digital signature for the purpose of authenticating incoming message.

In respect to claim 12, Linehan and Yatsukawa disclose the method of claim 11. Linehan further disclose said method comprising:

"upon proper verification, generating a fourth message comprising information identifying the encode data file and said decode key, and transmitting said fourth message to said first computer" (see col. 7, lines 54-64).

In respect to claim 13, Linehan and Yatsukawa disclose the method of claim 12. Linehan further disclose said method comprising:

"receiving said fourth message at the first computer; accessing said encode data; and using said decode key in said fourth message to decode said encode data" (see col. 7, lines 54-64).

In respect to claims 27, Linehan and Yatsukawa disclose a method 25 and further disclose:

"secure link utilizes cryptographic protocols" (see col. 3, lines 10-13).

Allowable Subject Matter

6.   Claims 28 and 33-37 are allowed.

Claims 14-15 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 28 is directed to a method of providing secure real time storage and retrieval of data between first and second computer in a secure link. The closest prior art, Linehan does not teach the features for obtaining a <u>secure save command from a user wherein said secure save command is embedded into a graphical user interface of a first computer system and said user of said secure save command of said graphical user interface initiates a process comprising the steps of generating an encoding key for encoding data and decoding key for decoding data in a second computer.</u>

Claim 33 is directed to a method for providing secure storage of data between a

client and server. The closest prior art, Linehan does not teach the features of

transmitting a secure save request from a client to a server said <u>secure save request</u>

<u>comprising a file name associated with a data file, an identification value associate with</u>

<u>said client and a one-way hash function of said data file and generating, at said server,</u>

<u>a first encryption key for encoding and a second encryption key for decoding</u>. The

second closest art is Applicant's admitted prior art (specification, page 3, U.S. Patent

NO. 5,136,647 by Harber et al.), teaches a system for applying one-way hash function

and a time stamp into a digital data and said system enables the detection of any

alteration of the content of the digital document by examining the hash function, the time

stamp and digital signature associated with the document.

Dependent claims 29-32 and 34-37 are allowed because by their dependency

they contain the language of the independent claims.

Dependent claims 14-15 teach the feature of generating a data retrieval

timestamp after a successful verification of digital signature and storing said data

retrieval timestamp. The cited prior art, Yatsukaw and Applicant's own admitted prior

art teach that the timestamp is generated before a verification of digital signature is

performed.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
Art Unit: 2134

TT

May 11, 2004

MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137